



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/490,666	01/24/2000	Robert Alvin Mohror	1203	7465
27142	7590	10/16/2003	[REDACTED]	[REDACTED] EXAMINER
MCKEE, VOORHEES & SEASE, P.L.C. ATTN: PIONEER HI-BRED 801 GRAND AVENUE, SUITE 3200 DES MOINES, IA 50309-2721			[REDACTED] FOX, DAVID T	[REDACTED]
			ART UNIT	PAPER NUMBER
			1638	

DATE MAILED: 10/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/490,666	MOHROR, ROBERT ALVIN
	Examiner	Art Unit
	David T. Fox	1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 08 July 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,52-60 and 66-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) 1,2,4,52-54,66 and 71 is/are allowed.
- 6) Claim(s) 3,55-60,67-70 and 72-75 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.
2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) Other: _____

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08 July 2003 has been entered.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-4, 52-60 and 66-75 are pending. The amendments of 08 July 2003 have obviated the outstanding indefiniteness rejections.

Claims 70 and 72 (amended) are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 70 is indefinite for its recitation of improper Markush terminology. Replacement of "or" in line 4 with -- and -- would obviate this rejection.

Claim 72 is indefinite in its recitation of "the inbred maize plant" which lacks antecedent basis in claim 54.

Claims 3, 55-60, 67-69 and 73-75 (newly amended) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the

inventor(s), at the time the application was filed, had possession of the claimed invention, as stated in the last Office action on page 2 for claims 55-61, 63, and 67-70.

Claims 3, 55-60, 67-69 and 73-75 (newly amended) are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, as stated on pages 2-3 of the last Office action for claims 55-61, 63 and 70.

The claims remain free of the prior art, as stated on page 3 of the last Office action.

Claims 1, 2, 4, 52-54, 66 and 71 are allowed.

Applicant's arguments filed 08 July 2003, insofar as they pertain to the rejections above, have been fully considered but they are not persuasive.

Applicant urges that the written description rejection is improper, given the knowledge of the skilled artisan regarding hybridization or backcross introgression methods, the availability of molecular marker analysis as illustrated by Openshaw et al, the known presence of half of the claimed inbred in any F1 hybrid progeny, the lack of a requirement for the recitation of phenotypic and morphological characteristics, and the amendments to the claims.

The Examiner maintains that the knowledge of breeding techniques does not address the issue of the adequacy under 35 USC 112, first paragraph, of the written description of the plants involved in those techniques or produced by those techniques.

The techniques taught by Openshaw et al were not disclosed in the specification. Furthermore, Openshaw et al admit that linkage drag will interfere with their success (see, e.g., page 43, column 1, bottom paragraph), and that at least four generations of crosses are needed to constitute more than 90% of the recurrent parent genome (see, e.g., page 41, Table 1). Since the claims do not recite a particular number of crossing generations, they read on plants with much fewer than 90% of the recurrent parent genome, and with a substantial portion of the genome from a multitude of uncharacterized donor parents. Even claims drawn to an F1 hybrid with 50% of the parental inbred genome are not adequately described, since the remaining 50% is derived from a multitude of uncharacterized crossing partners. Regarding the Examiner's focus on morphology, since Applicant has not disclosed any actual genetic complement of the inbred, wherein the individual traits exhibited by the inbred are governed by genes not necessarily unique to that inbred, and since it is the combination of traits which renders the inbred unique, such a focus is warranted. In the absence of any genetic information, one skilled in the art would not have recognized Applicant to have been in possession of the claimed invention unless morphological traits were disclosed.

Applicant urges that the enablement rejection is improper, given the deposit of the inbred, and the lack of a requirement to teach what is well known in the art, wherein one skilled in the art could evaluate the various traits of the plant products.

The Examiner maintains that the deposit of the inbred does not address the enablement of claims drawn to processes of crossing that inbred with a multitude of

undisclosed partners. Although backcross breeding may be known in the art, the obtention of a single gene conversion plant, which retains all of the unique complement of traits except for the introduction of a single introgressed trait, is not well-known, as stated on page 5 of the last Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-0280. The examiner can normally be reached on Monday through Friday from 10:30AM to 7:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached on (703) 306-3218. The fax phone number for this Group is (703) 872-9306. The after final fax phone number is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

October 7, 2003

DAVID T. FOX
PRIMARY EXAMINER
GROUP 1638

